Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BILL A. CRANDALL and ROBERT O. GROOVER

Appeal No. 2001-1075
Application No. 09/191,098

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 7, 9 through 13 and 15, all of the claims remaining in this application. Claims 8, 14 and 16 through 18 have been canceled.

Appellants' invention relates to an intermittently wetted sliding amusement ride. As noted on pages 3 and 4 of the

specification, the invention discloses a new principle for water ride operation, in that lubrication is provided not by a flow of water, but by a spray of water on the weight-bearing surface of the slide, which is interrupted (turned off) before each rider arrives. According to appellants, the inner surface of the slide will thus hold a water film for long enough for the raft or sled to pass through, while still providing high lubrication and a very fast ride. Appellants note that this approach permits the ride to be operated with a much lower supply of water and provides the crucial advantage that the riders do not get wet, thus extending the operating season and allowing the ride to be used in conventional amusement parks where the users/riders are not expected to wear swimsuits. Independent claims 1 and 15 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellants' brief.

The sole prior art reference relied upon by the examiner in rejecting the appealed claims is:

Langford 5,230,662 Jul. 27, 1993

Claims 1 through 7, 9 through 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Langford. After identifying similar structures in the waterslide of Langford and appellants' claimed amusement ride (i.e., a slidable surface, a structural support for the slidable surface, rider vehicles, and wetting means), the examiner notes that Langford does not specifically disclose a spraying means for creating a water film on the slide before the approach of each ride vehicle. However, the examiner concludes that

> "such feature is merely an intended use of the spraying wetting means; the spraying wetting means of Langford is certainly capable of being controlled and/or adjusted in any desired manner. Therefore, it would have been a matter of design choice to control and/or adjusted the spraying wetting means of Langford to discharge water before the approach of each rider" (answer, page 3-4).

Rather than reiterate the examiner's full discussion of the above-noted rejection and the conflicting viewpoints

advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 12, mailed July 17, 2000) for the reasoning in support of the rejection, and to appellants' brief (Paper No. 11, filed April 25, 2000) and reply brief (Paper No. 13, filed August 18, 2000) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims[1], to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

[1] Contrary to the examiner's indications in the answer (page 2), the copy of the claims contained in the Appendix to appellants' brief is not correct. The record reflects that claims 2 through 7 are dependent upon claim 1 and not claim 3 as is shown in the copy of claims in the Appendix to the brief.

Having reviewed and evaluated the applied Langford reference, we are of the opinion that the examiner's position regarding the purported obviousness of claims 1 through 7, 9 through 13 and 15 on appeal represents a classic case of the examiner using impermissible hindsight in order to reconstruct appellants' claimed subject matter. In our opinion, there is no teaching or suggestion in Langford which would have reasonably led one of ordinary skill in the art to modify the wetting means identified therein by the examiner so as to correspond to the "spray wetting means" of claim 1 on appeal or the "wetting mechanisms" set forth in claim 15 on appeal, and so as to thereby operate only when rider vehicles are not present (as specified in appellants' independent claim 15), or to create a water film on the slidable surface before the approach of each rider vehicle as in appellants' independent claim 1. In that regard, we do not share the examiner's view that the wetting means (50, 52, 132, 136) of Langford are capable of being controlled and/or adjusted "in any desired manner" or that it would have been merely a matter of design choice to control and/or adjust the wetting means of Langford

to operate in the particular manner set forth in independent claims 1 and 15 on appeal.

In reaching the above conclusions, we consider that the examiner has failed to properly interpret the "spray wetting means" of claim 1 and the "wetting mechanisms" of claim 15 in accordance with 35 U.S.C. § 112, sixth paragraph. As was made clear in In re Donaldson Co. Inc.,16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), the sixth paragraph of 35 U.S.C.
§ 112 permits an applicant to express an element in a claim for a combination as a means or step for performing a specified function without the recital of structure, materials or acts in support thereof, and mandates that such a claim limitation

> "shall be construed to cover the corresponding structure, materials, or acts described in the specification or equivalents thereof."

In this case, it is clear to us, as has been urged by appellants in their brief, that the wetting means of Langford are not the same (structurally or functionally) as those

described in appellants' specification, and also clear that the examiner has not attempted to articulate any reasoning as to why the structure of the applied Langford reference should be considered to be an equivalent of that which is set forth in appellants' specification and claims.

Langford describes the first wetting means (50) therein as injecting water into the trough and establishing a gravity flow of water in a forward direction relative to the rider path along the downhill section of the trough, which water flow supports the riders in the chute and reduces friction between the riders (more particularly their support mats) and the chute walls. The second wetting means (52) of Langford is described as being used for injection of water into the trough adjacent an area of higher elevation along the uphill section (36) to thereby establish a flow of water in a backward direction relative to the rider path and sufficient to reduce surface friction along the uphill section. The water addition structure (132, 136) in Langford is said to be for injecting a plurality of water jets into the path of the riders for providing a flow that assists slower riders over the crest of

the hill and for adding a sufficient quantity of water directed over the crest of the hill so as to create a braking effect on the faster riders as well. Langford describes one example of the water addition structure (132, 136) as including five pairs of two inch diameter outlet pipes coupled to a pump providing a flow rate of water through the successive outlets of about 1000 gallons per minute.

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in the vehicles remain substantially free from being wetted.[2] Contrary to the examiner's position (answer, page 5), the differences between the claimed invention and Langford are not limited to "how the spray wetting means is being used," but in fact distinguish one from the other on the basis of both structure and function.

Since we have determined that the teachings and suggestions which would have been fairly derived from Langford would not have made the subject matter as a whole of independent claims 1 and 15 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection

[2] It appears to us that the recitations in dependent claim 10 on appeal wherein certain sections of the wetting mechanisms are controlled to turn on while rider vehicles are in a corresponding section of the slidable surface so that riders would be soaked when such is desired is inconsistent with the unqualified requirement in independent claim 15 that the wetting mechanisms be controlled to wet sections of the slidable surface "only when rider vehicles are not present in said sections" and whereby riders in the vehicles remain substantially free from being wetted. We leave it to the examiner and appellants to clarify this inconsistency during any subsequent prosecution of the application.

of those claims under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 2 through 7 and 9 through 13 under 35 U.S.C. § 103(a) based on Langford will also not be sustained. We note in passing that the examiner's theory (answer, page 5) regarding how Langford corresponds to the subject matter set forth in appellants' claims 2, 4, 9 and 12 on appeal (i.e., that the wetting means of Langford are clearly capable of being turned off at closing time) also reflects an improper construction of those claims under 35 U.S.C. § 112, sixth paragraph.

In light of the foregoing, the decision of the examiner to reject claims 1 through 7, 9 through 13 and 15 under 35 U.S.C. § 103(a) is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

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